

REMARKS

Claims 34-39 are currently pending in the current application. Each of claims 34-39 stands rejected by the Office Action mailed August 23, 2010. Claim 34 is amended by the present response. Claims 34-36 are independent claims, and claims 37-39 depend, either directly or indirectly, from claim 36. Applicants respectfully request reconsideration of the Application, in light of the following remarks.

Rejection of Claim 34 under 35 U.S.C. §112

Applicants begin by addressing the rejections under 35 U.S.C. §112, beginning with the rejection based on 35 U.S.C. §112, first paragraph. The Office Action asserts that

Applicant's specification (see page 44) teaches "(a)lternatively, a method of processing a coupon may comprise, for example, the following. A first party offers an item online for sale at a sales price amount. A coupon of a second party is associated with the item, the coupon having a coupon amount. A purchase request is received from a buyer for the item being offered online. The purchase request is responded to by requiring the buyer to pay a purchase amount corresponding to the sales price amount less the coupon amount for the item. And the second party electronically pays a payment amount corresponding to the coupon amount to the first party". The specification however does not teach offering, by a second system of a second party, an item for sale online at a sales price amount, *wherein the item for sale can be identified on the second system by a customer using the second system.*

(Office Action at p. 2-3; emphasis in original.) Applicants respectfully traverse this rejection. As an initial matter, whether or not the particular embodiment described at p. 44 does or does not disclose identification on the second system by a customer using the second system does not determine whether the written description requirement is satisfied. Instead, the specification as a whole must be considered. For example, in the previous submission, Applicants pointed out that there is support in the specification at, for example, page 15. (See June 04, 2010 Response at p. 5.) As also indicated in the previous submission, support for the previous amendment to claim 34 may be found in the Specification, for example, at p. 15, lines 11-18, which states "After selecting the desired items into a shopping cart, the customer invokes a rebate and coupon button on a screen...if

any items in the shopping cart are not specific enough to unambiguously identify a manufacturer, **the system 15 returns coupons for multiple manufacturers of similar products for the customer to choose from.**”; emphasis added.) Thus, in certain embodiments, the system 15 may offer the item for sale online at a sales price amount (for example, p. 12 lines 5-12 provides one example of the system 15 offering items for sale online). The specification also describes certain embodiments of the system 15 that also provide a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party (in the example on p. 15, the first party being a manufacturer), and wherein the customer identifies the item on the second system (for instance, by selecting the desired items into a shopping cart, or, as another example, by selecting from a catalog as described at p. 12, lines 5-12). Thus, Applicants respectfully submit that the written description requirement is satisfied, as the Specification more than adequately describes wherein the item for sale can be identified on the second system by a customer using the second system as fully set forth in claim 34.

Applicants next turn to the rejection based on 35 U.S.C. §112, second paragraph. The Office Action asserts that claim 34 is “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” (See Office Action at p. 3.) The Office Action explains this rejection as follows:

Claim 34 as amended recite [sic] “wherein the item for sale can be identified on the second system by a customer using the second system”. Does it mean that the customer is using the second party’s computer system? It is unclear what applicant considers a “system”. If the items for sell [sic] are offered by a second system and if the customer is identifying the items using second system, it is unclear whether the second system is a website, a server or a computer.”

(*Id.* at p. 3-4; emphasis in original.) As an initial matter, Applicants note that the word “system” has been present, in some form, in claims throughout the prosecution of the present application. Yet, now, for the first time, the Office Action asserts the word “system” is somehow not clear. This belated assertion is contrary to MPEP § 2106 (II) (“It is essential that patent applicants obtain a prompt yet complete examination of their applications...each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application...USPTO personnel should state all reasons and bases for rejecting claims in the first Office action.”)

In any event, the specification is replete with examples of various embodiments and variations of systems. (See, for example, Specification at p. 11 (“...In addition the system 15 is linked via appropriate connections 45 to information systems at one or more manufacturer or merchant environments 25. Such information system include appropriate Internet web hosting services”; “the system 15 performs many functions....Thus, the system 15 automates the traditional human intensive coupon and rebate processing”; “The system 15 supports automatic and manual adjustments of promotional offerings...”; p. 12 (“...Customers are presented with a catalog of products to choose from, by the web server 20 associated with the system for online sales with automatic rebate and coupon redemption 15, when they visit the system for online sales with automatic rebate and coupon redemption 15...”; p. 13 (In one embodiment of the present invention, a customer using the computer 5 with the Internet connection 30, accesses one or more rebate and coupon dispensing web pages present by a server environment 20 associated with, and communicatively coupled with, the system for online sales with automatic rebate and coupon redemption 15...”; p. 14 (“In one embodiment, the system 15 serves as a front end to the e-commerce sites of manufacturers and merchants wherein customers purchase products from the system 15 and reimburse it, say via credit cards, for the products purchased online. The system 15 in turn acquires the products...”; p. 15; p. 16 (“Fig. 2 is a diagram showing the various inputs and outputs of the system...”; p. 18-19 (“Fig. 4 is a block diagram showing exemplary components of the system for online sales with automatic rebate and coupon redemption 15. The system 15 includes a browsable catalog 480 through which customers can select one or more products for purchasing, a search engine 485 for searching for specific products based on one or more criteria, an Authentication Manager 405 for verifying the authenticity of coupons and rebates presented to it for redemption, and a Dispenser 410 which dispenses coupons and rebates generated by a Generator 420...Online Customers 450 access the system 15 over the connection 455. They can browse through the online browsable catalog...”; p. 20.)

These are but some of the numerous examples of systems discussed in the Application. While no one particular example system is necessarily a limiting or exclusive definition of a system, Applicants respectfully submit that one skilled in the art would certainly understand what is meant by system. Further still, “system” is a commonly used term that is understood, for example, as “an assemblage or combination of things or parts forming a complex or unitary whole” or “a group of interacting, interrelated, or interdependent elements forming a complex whole.” (See, e.g., definition

of “system” at Dictionary.com.) In the context of claim 34, such a second system is also described as, *inter alia*, offering an item for sale online. Also, for example, claim 34 recites that the second system is of a second party. Such a system is not necessarily limited to an individual computer, network, and/or server but may, as appropriate, include computer(s), network(s), and/or server(s) and/or be associated and/or communicatively coupled to other computer(s), network(s), and/or server(s) that may or may not be part of the system.

Rejection of Claim 34-35 as Anticipated by Meyer

Applicants next address the rejection of claim 34 under 35 U.S.C. §102(e) as being purportedly anticipated by Meyer *et al.*, U.S. Patent No. 6,915,271 (hereinafter “Meyer”). As an initial matter, Applicants respectfully traverse the rejection as set forth by the Office Action, at least for similar reasons as discussed in previous submissions. Nevertheless, Claim 34 is amended by the present response to even further clarify the presently claimed subject matter and to help expedite prosecution of certain aspects of the presently claimed subject matter. Claim 34 is amended by the present response to recite, in addition to limitations discussed in previous submissions, “providing, **by the second system**, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount.” Support for this amendment may be found in the Specification, for example, at p. 15, lines 11-18 (“After selecting the desired items into a shopping cart, the customer invokes a rebate and coupon button on a screen...if any items in the shopping cart are not specific enough to unambiguously identify a manufacturer, **the system 15 returns coupons for multiple manufacturers of similar products for the customer to choose from.**”; emphasis added.)

To anticipate, a single prior art must disclose each and every element as set forth in the claim, either expressly or inherently described. (*See* MPEP § 2131.) “The **identical** invention must be shown in **as complete detail** as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Further, the elements of the claim must be arranged as required by the claim. As further discussed below, Applicants respectfully submit that Meyer does not disclose each and every

element of the presently claimed subject matter in the required detail or arranged as required, and does not anticipate the presently claimed subject matter.

Applicants respectfully traverse the rejection of claim 34 as anticipated by Meyer. For example, the Office Action relies on “Target, Holt, EB, amazon.com,” for example, as second systems. (See Office Action at p. 4.) However, the promotions in those examples are from the same entities, and therefore such an arrangement cannot teach the limitations of claim 34 as arranged by claim 34 (for example, a second system offering items for sale online, and promotions coming from a distinct first party).

Explaining its rejection of claim 34, the Office Action states as follows:

The items of Meyer that are sold at the merchants (e.g. at Sony, Marriott, Target, amazon.com etc) can be identified by the customer before the customer browses at the coupon site. The customer can also browse the coupon site after identifying an item at the merchants to see if there is any coupon at the coupon site, or the customer can directly to the coupon site, click at the hyperlink to link to the merchant site and purchase the product using the discount.

(Office Action at p. 5.) Applicants respectfully submit that such identification of items sold at merchant sites before browsing the coupon site would not teach at least searching “for the promotion **after** the customer has identified the item for sale on the second system.” This is even more so in light of the Office Action’s reliance, at p. 4, of the merchants as providing the second system, as the Office Action appears to be relying on both a purported merchant site as well as a distinct “coupon site” as teaching the second system. Such a purported arrangement would not be arranged as required by claim 34 and therefore cannot anticipate. Applicants respectfully submit that separate searches of distinct sites by a customer does not teach “providing a portal” as fully set forth by claim 34, and thus a customer independently browsing a “coupon site” after identifying an item at a merchants site cannot teach the presently claimed subject matter. Similarly, browsing at a purported “coupon site” and then linking to a merchant site does not teach, for example, wherein a customer can search for a promotion **after** the customer has identified the item for sale.

Responding to Applicants’ previous submission, the Office Action states:

...Examiner points out that in Meyer the items for sale, for example at Target or amazon.com, can be identified by the customer through the Target website or amazon.com website respectively. After an item being identified by the customer the customer can access the isavings site to search for the promotions and purchase the item from the isavings site by linking to Target or amazon.com website...

(Office Action at pp. 8.) Meyer, even as asserted by the Office Action, does not anticipate claim 34. Again, purportedly “identifying” an item at a Target or amazon website, and then separately going to a distinct “isavings” website to search for a promotion does not teach providing a portal as fully set forth by claim 34. Further still, purchasing an item by “linking” to Target or amazon does not teach, for example, offering for sale as fully set forth by claim 34.

In any event, claim 34 is amended to even more clearly specify that the portal provided after the item is selected is provided by the second system. Support for this amendment may be found, for example, at pages 12-15 of the Specification. Again, p. 12 provides an example of selecting an item for sale on the second system, and p. 15 provides an example of the second system providing a portal after item is selected for sale (“the system 15 returns coupons for multiple manufacturers of similar products for the customer to choose from”). Applicants respectfully submit that the cited art does not teach such a providing a portal by the second system. Instead, even as asserted by the Office Action, Meyer merely teaches a customer performing separate searches on its own. Such independent, distinct searches done separately by the customer do not teach providing a portal by the second system (the same system, for example, that offers an item for sale online) after the item is identified on the second system. For at least the above discussed reasons, Applicants respectfully submit that Meyer does not teach at least “offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system” or “providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, the promotion having a promotion amount” as fully set forth by claim 34. As such, Applicants respectfully submit that Meyer does not anticipate claim 34, and that claim 34 is allowable.

Next, Applicants turn to the rejection of claim 35. Applicants respectfully traverse the rejection as set forth by the Office Action, at least for similar reasons as discussed in previous submissions. As also discussed in previous responses, Claim 35 recites, for example “offering, by a second system of a second party, an item for sale online at a sales price amount,” where the item for sale has associated with it by the second system of the second party “a promotion from the first party,” and further recites that “the second system is distinct from the first system and the second party is distinct from the first party.” Applicants further note that claim 35 also recites that the promotion from the first party has “a promotion amount,” and further recites “receiving, by the second system, an online purchase request,” “responding, by the second system, to the online purchase request by collecting from the buyer...,” and “causing, by the second system, shipment by the second party...” As such, the party which the promotion having a promotion amount is from (the first party) is different from the party offering an item for sale online at a sales price, receiving an online purchase request, responding to the online purchase request by collecting a purchase amount, and shipping the item. Put another way, the promotion having a promotion amount comes from a first party that is distinct from the second party (the party, *inter alia*, offering the item for sale online at a sales price amount, receiving a purchase request, and collecting a purchase amount).

In responding to Applicants’ previous assertions, the Office Action states that

“...Meyer teaches in an alternative embodiment of the buy now procedure, the purchase screen is a pop-up that asks the member for all information necessary to complete the purchase...In yet another alternate embodiment, the service provider actually charges the purchase to the member’s credit card, and then informs the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase (i.e., to send the product to the member)...the member then is provided with the necessary information to collect the goods or with a confirmation that delivery will take place...since an actual incentive redemption took place, the redemption recording activities described below also need to take place. Therefore, Meyer teaches a second party (service sponsor) selling items (vendor items online having associated with it a promotion (provided by incentive issuer) (see col. 41 lines 23-41). Meyer also teaches that the sponsor may

sponsor a campaign run directly by an incentive issuer (e.g., a manufacturer) or by a promotion agency...

(See Office Action at p. 9-10.) Even as asserted by the Office Action, such teachings cannot anticipate claim 35. For example, regardless of whether information is collected to complete the purchase, “inform[ing] the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase” does not teach “causing, by the second system, **shipment by the second party...**” as expressly required by claim 35. Instead, in the cited portions of Meyer different parties/systems offer an item for sale and ship the item. Further, the Office Action asserts a “service sponsor” as the second party. However, claim 35 requires, *inter alia*, “receiving, by the second system, an online purchase request,” “responding, by the second system, to the online purchase request by collecting from the buyer...”, and “causing, by the second system, shipment by the second party...” The Office Action does not identify where the “service sponsor” performs all these functions. As with previous submissions, the Office Action mixes and matches different activities by different parties. In contrast, claim 35 requires specific different attributes between a first system of a first party and a second system of a second party, and requires those parties/systems to be distinct. The asserted portions of Meyer do not arrange these limitations arranged as required by claim 35 and cannot anticipate claim 35.

For at least the above reasons, as well as those discussed in previous submissions, Applicants respectfully submit that Meyer does not anticipate claim 35, and that claim 35 is allowable.

Rejection of Claims 36-39 as Unpatentable Under 35 U.S.C. §103

Claim 36 and its dependent claims stand rejected as being unpatentable over Meyer in view of various other references. As an initial matter, claim 36, similar to claim 35, expressly recites that the first party (which the promotion having a promotion amount is from) and the second party (which offers an item for sale online), as well as the first and second systems, are distinct. Further, the Office Action relies solely upon Meyer as teaching the common aspects shared between claim 35 and claim 36. As discussed above and in previous submissions, Applicants respectfully submit that the additionally cited references do not remedy the above

shortcomings in the disclosure of Meyer, and that claim 36 and its dependent claims are allowable for at least similar reasons as those discussed above with respect to claim 35 and in previous submissions.

In the previous submission, Applicants demonstrated the failure of the cited art to teach "...wherein the item has been acquired by the second party from the first party..." The Office Action, in large part, repeats its assertions regarding claim 36, which have already been addressed by Applicants in previous submissions. Responding to Applicants' previous submission, the Office Action states

If applicant is indicating that in claim 36 the item has to be fiscally acquired by the second party from the first part [sic], the vendors in Meyers also first acquire the products from the manufactures [sic] to be sold online. Meyers also teaches that the items acquired have a promotion from the manufactures [sic] or from the vendors themselves. Myers teaches (see col. 22 line 31 to col. 23 line 20) each incentive is defined by an incentive template...

(See Office Action at p. 10.) As an initial matter, the Office Action does not identify what the vendors/manufacturers are, nor does the Office Action provide any citation for its assertion that "the vendors in Meyers also first acquire the products from the [manufacturers]. Further, Applicants are unable to find any example, teaching, or suggestion in Meyers of having a promotion from a manufacturer of goods, a separate and distinct vendor acquiring the goods from the manufacturer, and the vendor offering the goods for sale online, let alone the subject matter of claim 36 as fully set forth. In any event, even as asserted by the Office Action, none of these purported teachings teach, suggest, or otherwise render obvious the subject matter of claim 36 or its dependent claims. For example, the Office Action does not identify or explain how or why one skilled in the art would understand the purported "manufacturers" as teaching, suggesting or otherwise rendering obvious all of the aspects of the first party/first system recited by claim 36, nor how or why one skilled in the art would understand the purported "vendors" as teaching, suggesting or otherwise rendering obvious all of the aspects of the second party/second system recited by claim 36. Whether or not vendors acquire products from manufacturers cannot be stretched so far as to teach, suggest, or otherwise render obvious a promotion from a first

party having a first system, and a distinct second system of a distinct second party offering an item for sale online that has been acquired by the second party from the first party, with the item for sale having associated with it a promotion from the first party.

For example, the Office Action relies on incentives stored in a database that have an “Incentive Name ‘sonycam-100’”, “Issuer, the identification of the manufacturer or supplier of the goods or services”, and “Product, a list of goods or services to which the incentive applies.” (See Office Action at p. 10.) The fact that an incentive has a name teaches nothing with respect to whether that incentive is of a first party or a second party, let alone the distinctions of those parties as fully set forth in claim 36. Further, that a good or service has an “Issuer” does not teach the presently claimed subject matter. For example, that a good or service has a manufacturer or supplier does not teach whether that manufacturer or supplier has anything to do with an incentive, let alone the subject matter of claim 36 as fully set forth. Similarly, the mere fact that there is a list of goods or services to which an incentive applies does not teach the distinctive arrangement of the first and second parties and systems as set forth by claim 36.

For at least the above reasons, in addition to the reasons given in previous submissions, Applicants respectfully submit that the Office Action does not present a *prima facie* showing of obviousness for claim 36 or any claim dependent therefrom; that the cited references, either alone or in combination, do not teach, suggest, or otherwise render obvious those claims; and that those claims are allowable.

Conclusion


In general, the Office Action makes various statements regarding the pending claims and the cited reference that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicants believe that the pending claims are allowable. Should the Examiner disagree or have any questions regarding this submission, Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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